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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/081,707	05/19/98	ISAACS	J 07265/149001

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EXAMINER

HUFF, S

ART UNIT	PAPER NUMBER
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1642

12

DATE MAILED:

11/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/081,707

Applicant(s)

Isaacs et al

Examiner

Sheela J. Huff

Group Art Unit

1642

☒ Responsive to communication(s) filed on Sep 29, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-77 is/are pending in the application.

Of the above, claim(s) 18-77 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 and 17 is/are rejected.

☒ Claim(s) 16 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4,5,6,8

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of Group I, claims 1-17 in Paper No. 10 is acknowledged.

Claims 18-77 are withdrawn from consideration.

Information Disclosure Statement

2. The IDS's filed 9/28/98, 6/1/99, 6/28/99 and 8/4/99 have been considered and initialed copies of the PTO-1449's are enclosed.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The disclosure of claim 16 is not in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-12 are rejected under 35 U.S.C. 102(a) as being anticipated by DeFeo-Jones et al US 5599686.

This reference discloses oligomers containing KISTQ, and variations thereon that read on applicant's generic formula X5X4X3X2X1 (see col. 3-5 and the CLAIMS). The length of the oligomers range from 7-100 amino acids, but as exemplified in the disclosure the oligomers are less 20 amino acids in length. The protecting groups used are conventional protecting groups and include benzyloxycarbonyl (col. 14, line 31). Compositions are also discloses (col. 18+).

6. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by DeFeo-Jones et al WO 96/00503

This reference discloses oligomers containing KISTQ, and variations thereon that read on applicant's generic formula X5X4X3X2X1 (p. 9+). The length of the oligomers range from 6-100 amino acids, but as exemplified in the disclosure the oligomers are less 20 amino acids in length. The protecting groups used are

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conventional protecting groups and include benzyloxcarbonyl (p. 9). Compositions are also discloses (p. 40+).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeFeo-Jones et al US 5599686 or DeFeo-Jones et al WO 96/00503 in view of applicant's admission on page 8, lines 8-19..

The DeFeo-Jones et al reference has been discussed above.

The only difference between the instant application and the reference is that the reference does not specifically mention the other protecting groups, does not specifically mention the water soluble substituent or that the peptides can be used as a combination.

Applicant admits on page 8 of the specification that the capping groups and water-soluble substituents are well known in the art and that their use is routine.

Thus, in view of routine use of the capping groups and the water-soluble substituents, it would have been obvious to one of ordinary skill in the art at the time of the invention it use any known capping group and/or water-soluble substituent with the oligomers of the primary reference. The use of many different oligomers is within the purview of one skilled in the art.

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Allowable Subject Matter

10. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 16 is free from the art of record because the prior art neither teaches nor suggests the conjugation of PSA to antibodies.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DeFeo-Jones et al US 5866679--this reference is the US equivalent of WO 96/00503 and the claims of the US patent read on the instant invention.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J. Huff whose telephone number is (703) 305-7866. The Examiner can normally be reached on Monday, Wednesday and Thursday from 6:30am to 4:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Paula Hutzell, can be reached on (703)308-4310.

The FAX phone number for the group is (703)308-4242.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [paula.hutzell@uspto.gov].

All Internet e-mail communications will be made of record in the application file.

PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the

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record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-0196.

Sheela J. Huff
November 22, 1999

A handwritten signature in cursive script that reads "Sheela J. Huff".

Sheela J. Huff
Primary Examiner